

Applic. No. 10/033,127

Amdt. dated February 19, 2004

Reply to Office action of November 19, 2003

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-5, 7-10, and 12 remain in the application. Claims 1, 10, and 12 have been amended. Claim 6 has been cancelled.

In item 2 on page 2 of the Office action, claims 1-4, 7-10, and 12 have been rejected as being obvious over Jeschke et al. (U.S. Patent No. 4,089,264) (hereinafter "Jeschke") in view of Dini (U.S. Patent No. 3,964,386) under 35 U.S.C. § 103.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found in claim 6 of the instant application.

Since claims 1, 10, and 12 were amended to include the subject matter of claim 6, and since claim 6 was not rejected in item 2, the rejection over Jeschke in view Dini has been overcome.

In item 3 on page 5 of the Office action, claim 5 has been rejected over Jeschke (U.S. Patent No. 4,089,264) in view of Dini (U.S. Patent No. 3,964,386) and further in view of Cappel

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et al. (U.S. Patent No. 3,913,479) under 35 U.S.C. § 103.

Cappel et al. do not make up for the deficiencies of Jeschke and Dini. Since claim 1 is believed to be allowable, dependent claim 5 is believed to be allowable as well.

Because claims 1, 10, and 12 were amended to include the subject matter of claim 6, the rejection listed below will be discussed with regard to amended claims 1, 10, and 12.

In item 4 on page 6 of the Office action, claim 6 has been rejected over Jeschke (U.S. Patent No. 4,089,264) in view of Dini (U.S. Patent No. 3,964,386) and in further view of Olawsky et al. (U.S. Patent No. 5,842,416) (hereinafter "Olawsky") under 35 U.S.C. § 103.

It is noted that the corporate assignee of the Jeschke and Olawsky references is also the corporate assignee of the instant application. Therefore, applicant is very familiar with these references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1, 10, and 12 call for, *inter alia*:

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at least one glazing roller disposed downline from the metering element along a peripheral line of the roller, the glazing roller being exclusively in rolling contact with the roller.

As will be seen from the following comments pertaining to the technical background of Jeschke and Olawsky, any teaching, suggestion, or incentive possibly derived from the prior art for the Examiner's rejection of claim 6 is only present with hindsight judgment in view of the instant application.

There are two entirely different types of inking units.

A first type pertains to inking units which are divided into inking zones. In this type of inking unit the ink metering occurs by zone. The inking unit disclosed in Jeschke belongs to this type. Jeschke discloses that Jeschke's invention "relates to an inking unit for printing machines that includes an ink duct, a duct roller, an ink transfer roller, and inking unit rollers, and wherein the amount of ink to be transferred to the inking unit rollers or mechanism is adjustable zonewise by means of a ductor knife" (column 1, lines 3-8).

The second type of inking unit pertains to inking units which have no inking zones, and thus operate without any zonal ink

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metering. The inking unit disclosed in Olawsky, which is actually prior art known from the German periodical: Deutscher Drucker (German Printer), No. 36, Sep. 28, 1995, page W64, (column 1, lines 36-44 of Olawsky), pertains to this second type of inking unit. Olawsky discloses that the periodical Deutscher Drucker discloses that "this inking unit, which has been constructed for uniform page-wide ink application, does not permit any finely controlled zonal ink metering, as is required in high-quality multicolor printing" (column 1, lines 40-44 of Olawsky). Once again it is noted that this disclosure pertains to the disclosure of the periodical Deutscher Drucker and does not pertain to the inking unit of the invention according to Olawsky.

The Jeschke reference pertains to inking units having inking zones and the teaching of Olawsky, which is actually known from the periodical Deutscher Drucker (as noted above), pertains to inking units which have no inking zones. Therefore, it is respectfully believed that any teaching, suggestion, or incentive possibly derived from these entirely different types of inking units, for the Examiner's rejection of claim 6 is only present with hindsight judgment in view of the instant application.

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Furthermore, it is noted that the Dini reference does not make up for the deficiencies of Jeschke and Olawsky.

Moreover, A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed

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in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence."

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Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 10, or 12. Claims 1, 10, and 12 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-5, 7-10 and 12 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone

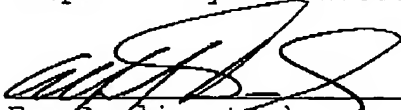
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call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,



For Applicant(s)

Alfred K. Dassler
52,794

AKD:cgm

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Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101